

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re PATENT application of) Confirmation No.: 1644
Kojiro OKAMOTO et al.)
Application No. 09/744,595) Examiner: Jorge L. Ortiz Criado
Filed: January 26, 2001) Group Art Unit: 2656
For: REPRODUCING APPARATUS)
AND RECORDING MEDIUM) Date: October 23, 2006

APPEAL BRIEF

MAIL STOP APPEAL BRIEF – PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal is from the decision of the Examiner dated January 17, 2006, finally rejecting claim 29, which is reproduced as the Appendix A of this brief and is the sole pending claim in this application.

The Commissioner is hereby authorized to charge The \$500.00 government fee under 41.20(b)(2) due with the submission of this brief and any other fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 19-2380.

I. REAL PARTY IN INTEREST

Matsushita Electric Industrial Co., Ltd. is the assignee of record and real party of interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellants, the Appellants' representative, or the assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claim 29 stands finally rejected and is the subject of this appeal. Claims 1-28 are canceled.

IV. STATUS OF AMENDMENTS

An amendment after final rejection was submitted on March 10, 2006, in which claim 29 was amended to address the rejection under Section 112, second paragraph, as first set forth in the final Office Action. In an Advisory Action issued on April 6, 2006, the Examiner indicated that the amendment to claim 29 would be entered for purposes of appeal, but he did not indicate whether the amendment would overcome the Section 112 rejection. Hence, it is believed that claim 29, as amended in Appellants' response of March 10, 2006, is the subject of this appeal, and the rejection under Section 112, second paragraph, remains pending.

V. SUMMARY OF INVENTION

This appeal includes only independent claim 29, which is summarized in the following:

Claim 29 is directed to a reproducing system (e.g., see Figure 5) for reproducing information in a disc-shaped writable recording medium (e.g., see page 7, lines 7-8 and Figures 1 and 5, item 10). The system comprises a disc-shaped medium (e.g., see Figure 1, item 10) having a primary recording region (e.g., see page 7, line

13 and Figure 1, item 20) for recording a data signal based on a user instruction and a secondary recording region which is located on the side of an internal periphery of said primary recording region (e.g., see page 7, lines 13-15 and Figure 1, item 30). The primary recording region has a track (e.g., item 21 in Figure 2) which wobbles at a first pitch (e.g., “P1” in Figure 2), and along which the data signal is recorded (e.g., see page 7, lines 17-20). The secondary recording region has a track (e.g., item 31 in Figure 3) which wobbles at a second pitch (e.g., “P2” as shown in Figure 3) different from said first pitch, and along which information pits (e.g., items 32) are formed to record a signal representative of primary control information (e.g., see page 8, lines 2-8). The primary control information in the secondary recording region includes an invalid key information item for inhibiting reproduction of main data encrypted in the primary recording region by using secondary control information recorded in the primary recording region, said secondary control information comprising information for decrypting the main data encrypted in the primary recording region (e.g., see page 8, lines 8-13).

The system recited in claim 29 includes a reproducing apparatus (e.g., see the description starting at page 8, line 22 and Figure 5) for the reproduction of the data signal on the primary recording region, including a pickup (e.g., see item 42) and for reading a digital signal from the recording medium under rotation, means for shifting the pickup (e.g., see page 9, lines 4-6 and Figure 5, item 43), and means for distinguishing if a reproduction location of the recording medium is the track which wobbles at said first pitch or the track which wobbles at said second pitch different from said first pitch (e.g., see page 10, lines 9-13 and Figure 5, item 70). It is to be noted that claim 29 recites the means for shifting the pickup and the means for distinguishing if a reproduction location of the recording medium in means-plus-function format as permitted by 35 U.S.C. § 112, sixth paragraph.

Claim 29 recites that at a system controller is connected to the pickup, the shifting means and the distinguishing means (e.g., see Figure 5, item 90) and that at a time when the reproducing apparatus is initially actuated to reproduce the data signal

from a track, the controller determines whether the track wobbles at the first pitch, and if so, shifts the pickup until the track wobbles at the second pitch, whereupon the primary control information in the secondary recording region is first reproduced, and the reproduction of main data encrypted in the primary recording region by using secondary control information recorded in the primary recording region is inhibited by the invalid key information item included in the primary control information in the secondary recording region (e.g., see page 11, line 23 to page 14, line 25 and Figure 7).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

- A. Claim 29 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.**
- B. Claim 29 stands rejected under 35 U.S.C. § 103, as allegedly being obvious over the combination of (1) Appellants' admitted prior art in pages 1 and 2 of the present specification; (2) Lokhoff et al. (US Patent No. 5,060,219) and (3) Timmermans et al. (US Patent No. 5,930,210).**

VII. ARGUMENT

- A. The Rejection of Claim 29 Under 35 U.S.C. § 112, Second Paragraph, Should Be REVERSED**

Claim 29 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter that Appellants regard as their invention. Appellants request withdrawal of this rejection for at least the following reasons:

In the final Office Action dated January 17, 2006, the Examiner asserted that

terminology recited in the preamble and line 15 of claim 29 is unclear. In response, Appellants submitted a response on March 10, 2006, in which claim 29 is amended in the preamble to recite “a reproducing system ...”, and by inserting in the next recited feature --a disc-shaped medium having-- in front of “a primary recording region” While the Advisory Action issued on April 6, 2006, at item number 7, indicates these amendments would be entered for the purposes of appeal, there is no mention of whether the amendments overcome the rejection under Section 112, second paragraph. However, it is believed that the rejection of claim 29 under 35 U.S.C. §112, second paragraph, has been obviated by Appellants’ changes to claim 29, which make it clear that the invention is a reproducing system comprised of the combination of a disc-shaped recording medium, and a reproducing apparatus for reproduction of a data signal on the recording medium. Reversal of this rejection is respectfully requested.

B. The Rejection of Claim 29 under 35 U.S.C. § 103 should be REVERSED

Introduction – The Examiner has Failed to Demonstrate a Motivation, Teaching, or Incentive to Combine the References Cited in his Sec. 103 Rejection

As instructed by MPEP § 2143 and the caselaw cited therein, to establish a *prima facie case* of obviousness, a criterion that must be met is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Appellants respectfully request the Board to reverse the Section 103 rejection, as there is simply no motivation, teaching or incentive within the purview of Section 103 that would have led a person of ordinary skill in the art to combine the various features of these references to arrive the invention recited in claim 29.

1. Sole Pending Claim 29

Claim 29 specifically recites a reproducing system for reproducing information in a disk-shaped writable recording medium, comprising the combination of (1) a recording medium having both primary and secondary recording regions which wobble at first and second pitches, wherein the secondary recording region includes a signal representative of primary control information that includes invalid key information for inhibiting reproduction of main data encrypted in the primary recording region, and (2) a reproducing apparatus that includes a pickup for reading a digital signal from the medium, a means for shifting the pickup, a means for distinguishing if a reproduction location of the recording medium is a track which wobbles at the first pitch or a track which wobbles at the second pitch, and

“a system controller connected to said pickup, said shifting means and said distinguishing means wherein, at a time when said reproducing apparatus is initially actuated to reproduce said data signal from a track, said controller determines whether such track wobbles at said first pitch, and if so, shifts said pickup until said track wobbles at said second pitch, whereupon said primary control information in said secondary recording region is first reproduced, and the reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region is inhibited by the invalid key information item included in said primary control information in said secondary recording region.”
(Emphasis added)

2. Claim 29 is Patentable over Each of the Cited References

As recognized by the Examiner in the Office Action mailed January 17, 2006, the admitted prior art neither discloses nor suggests a disk-shaped recording medium having primary and secondary recording regions wherein the primary recording region has a track which wobbles at a first pitch and a secondary recording region has a track which wobbles at a second pitch different from the first pitch. Even more importantly, the admitted prior art does not recognize the problem that the invention solves, i.e., the prevention of a reproducing apparatus from locating and reproducing a

key code such as a decryption code in a primary recording region prior to locating and operating on the basis of an invalid key code located in a secondary recording region of an R disk. For all these reasons, claim 29 is clearly patentable over the admitted prior art, taken singly.

Claim 29 is further patentable over the Lokhoff et al. patent, albeit for different reasons. The Lokhoff et al. patent discloses a recording system comprising a record carrier and a recording apparatus. The record carrier is provided with control information that informs the recording apparatus of the type of information that can be recorded on it (see column 5, lines 20 through 28). The control information will not allow the recording apparatus to record on the record carrier without a positive signal indicating that the data to be recorded is of the type that may be properly recorded (see column 5, lines 29 through 43). Because this system operates by initially preventing the recordation of selected types of data on the record carrier, it neither discloses nor suggests the recited disk-shaped writable recording medium having primary and secondary recording regions, wherein “said primary control information in said secondary recording region includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region,...” To the contrary, the control information in the record carrier of Lokhoff et al. prevents the recordation of selected types of data in the primary recording region from occurring at all. Hence, there is no disclosure, nor any need for the recited “invalid key information item for inhibiting the reproduction of main data encrypted in the primary recording region by using secondary control information recorded in said primary recording region” In the Lokhoff et al. patent, such “secondary control information” would not occur at all. Secondly, there is no disclosure or suggestion of a system controller which detects the pitches of the track wobbles such that the pickup of the reproducing apparatus is first shifted over the secondary recording region “whereupon said primary control information [i.e., said invalid key information] is first reproduced, and the reproduction of main data encrypted in said

primary recording region is inhibited by the invalid key information...” For all these reasons, claim 29 is clearly invalid over the Lokhoff et al. patent, taken singly.

The Timmermans et al. patent likewise neither discloses nor suggests the reproducing system specifically recited in claim 29. All this patent discloses is a system for recovering information from a record carrier, in which the information on the record carrier is recorded by way of variations of two different physical parameters, such that the recordation of information recorded via the second physical parameter is not copied by a conventional copy machine:

“due to the fact that a bit copying machine usually only copies the variations of the first physical parameter (which variations represent the information recorded) the variations in the second physical parameter are not copied. Consequently the special disk cannot be copied by the usual type of bit copying machines.” (See column 2, lines 3 - 8.)

Accordingly, the playback apparatus for the system disclosed in Timmermans et al. has a detection circuit 61 that seeks out information recorded via the second physical parameter (which may be a radial wobble) before information recovery is enabled. As set forth in column 6, line 53 – 56, “this means that information recorded on a record carrier without a radial wobble with said predetermined frequency cannot be recovered.” As such, the Timmermans et al. patent actually teaches against the recited, disk-shaped recording medium having primary and secondary recording regions, wherein the second recording regions has a track which wobbles at a second pitch, and wherein primary control information in the secondary recording regions “includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region” To the contrary, the information recorded via the radial wobble in Timmermans et al. always includes a valid key code information. Hence claim 29 is clearly patentable over the Timmermans et al. patent, taken singly.

3. There is no Motivation, Teaching or Incentive to Combine the References into the Invention Defined in Claim 29

These references are not properly combinable into the invention defined in claim 29. The admitted prior art only teaches the use of R disks having primary and secondary recording regions, wherein the secondary region includes invalid key information. The Lokhoff et al. patent discloses a record carrier having pre-recorded control information that limits the type of information that may be recorded on a primary recording region of the carrier. Hence, the teachings of Lokhoff et al. obviate the need for pre-recording invalid key information, as information not specifically approved by the control information is never recorded in the first place. The Timmermans et al. patent discloses a record carrier wherein valid key information is pre-recorded via a different physical parameter than information recorded on the balance of the carrier. Hence, the teachings of the Timmermans et al. patent also obviate the need for pre-recording invalid key information, as the valid key information cannot be copied by a standard bit copying machine since the valid key information is recorded via a different physical parameter.

In short, there is simply no teaching, suggestion or motivation within the references themselves to combine the various features disclosed therein in the manner recited in claim 29. To the contrary, the teachings of the admitted prior art, and the Lokhoff et al. and Timmermans et al. patents are fundamentally inconsistent with one another. While the Examiner recognizes the necessity of finding such a motivation, on page 10 of the Office Action, he fails to find it in the references themselves, and instead relies upon the teachings in the Appellants' own specification for the requisite teachings, suggestions and motivations to combine these references. While Appellants admit that disks are known having primary recording regions and secondary recording regions, wherein the secondary recording region includes invalid key information, Appellants do not admit that there is any recognition in the prior art as to the problem that may result from such a design; i.e., the reproduction of encrypted, copyrighted material as a result of (1) the copying of a valid decryption

key along with the encrypted information onto an R disk, and (2) the possibility that a conventional DVD reproducing apparatus will locate the recorded decryption information, and act on it, prior to locating the pre-recorded, invalid key information located in the secondary recorded region of the R disk. Without the recognition of the upper mentioned problem, there is simply no incentive, motivation or teaching in the prior art to combine the elements of the admitted prior art, Lokhoff et al. and the Timmermans et al. to arrive at the invention defined in claim 29. As such, the facts of the instant case parallel those of *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969), which held that

“it should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is *part* of the ‘subject matter as a whole’ which should always be considered when considering the obviousness of an invention under 35 USC Section 103...The court must be ever alert not to read obviousness into an invention on the basis of an applicants own statements; that is, we must view the prior art without reading into that art Appellant’s teachings.”

Appellants submit that without a recognition of the problem that the instant invention solves, that there is simply no incentive, teaching or motivation for the Examiner to combine the references in such a way as to arrive at the invention recited in claim 29. And as such a teaching, motivation or incentive is present only in Appellants’ own specification, Appellants submit that the rejection of claim 29 under 35 U.S.C. § 103 should be reversed.

For all the above reasons, it is believed the rejections of claim 29 under 35
U.S.C. §§ 112 and 103 should be reversed.

Respectfully submitted,

NIXON PEABODY, LLP

/John F. Guay, Reg.# 47248/
John F. Guay

Customer No.: 22204

NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, DC 20004
(202) 585-5000
(202) 585-8080 (Fax)

VIII. CLAIMS APPENDIX

29. A reproducing system for reproducing information in a disc-shaped writable recording medium, comprising:

a disc-shaped medium having a primary recording region for recording a data signal based on a user instruction and a secondary recording region which is located on the side of an internal periphery of said primary recording region,

wherein said primary recording region has a track which wobbles at a first pitch, and along which the data signal is recorded;

wherein said secondary recording region has a track which wobbles at a second pitch different from said first pitch, and along which information pits are formed to record a signal representative of primary control information; and

wherein said primary control information in said secondary recording region includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region, said secondary control information comprising information for decrypting said main data encrypted in said primary recording region and

a reproducing apparatus for the reproduction of said data signal on said primary recording region, including a pickup for reading a digital signal from said recording medium under rotation;

means for shifting said pickup; and

means for distinguishing if a reproduction location of said recording medium is the track which wobbles at said first pitch or the track which wobbles at said second pitch different from said first pitch, and

a system controller connected to said pickup, said shifting means and said distinguishing means wherein, at a time when said reproducing apparatus is initially actuated to reproduce said data signal from a track, said controller determines whether said track wobbles at said first pitch, and if so, shifts said pickup until said track wobbles at said second pitch, whereupon said primary control information in said

secondary recording region is first reproduced, and the reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region is inhibited by the invalid key information item included in said primary control information in said secondary recording region.

IX. EVIDENCE APPENDIX
(NONE)

X. RELATED PROCEEDINGS APPENDIX

(NONE)